

#13

<b>Interview Summary</b>	Application No.	Applicant(s)	
	09/964,919	GUPTA ET AL.	
	Examiner	Art Unit	
	Venkataraman Balasubramanian	1624	

All participants (applicant, applicant's representative, PTO personnel):

(1) Venkataraman Balasubramanian. (3) Ram Gupta.

(2) James Jubinsky. (4) \_\_\_\_\_.

Date of Interview: 6/17/2003.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1-11.

Identification of prior art discussed: all applied.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: 103 rejection over Hardy et al. made in the previous office action and Dr. Gupta's declaration filed after Final Action were discussed.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

V. Balasubramanian  
Examiner's signature, if required

### **DETAILED ACTION**

Applicant's election with traverse of Group I claims 1-11 in Paper No. 3 is acknowledged. The traversal is on the ground(s) that a) group III is not independent as it is a sub-combination and is novel if the triazines of the group I are allowable and b) the process claims of group II are to be joined with Group I if the triazines of the group I are allowable. This is not found persuasive because for reasons of record. In addition, contrary to applicants urging, there is no required combination. Group III can be used independently as noted in the previous office action and prior art applied to group I may not be applicable to group III. Furthermore, group II is not a process claims, they are method of use claims and hence they are distinct.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Recitation of the term "containing" in the definition of heterocyclic moiety in claim 1 renders the claim indefinite as the transitional phrase 'containing' is open-ended and can include more than what is being positively recited therein. See MPEP 2111.03 which states: The transitional term "comprising", which is

synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for various T and Z substituents in the triazine, does not reasonably provide enablement for T other than a direct bond and Z a halogen. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The following apply:

In evaluating the enablement question, following factors are considered. Note *In re Wands*, 8 USPQ2d 1400 and *Ex parte Forman*, 230 USPQ 546. The factors include: 1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The invention is drawn to trisubstituted triazines. Specification is not adequately enabled as to how to make compounds of formula (I) wherein the said triazine is

variously substituted with reactive functional groups such as hypohalide, S-halogen or N-halogen permitted in the T-Z definition.

These T-Z groups are reactive groups. Furthermore, since structurally analogous substituents are permitted in the other two substituents in the triazine ring, it is not clear how one would make such T-Z bearing compounds. Specification has no teaching as to how arrive at these T-Z substituted compounds. The presence of such reactive groups are chemically incompatible with the process of making taught in the specification.

2. The predictability or lack thereof in the art:

Hence the process as applied to the above-mentioned compounds claimed by the applicant is not an art-recognized process and hence there should be adequate enabling disclosure in the specification with working example(s).

4. The amount of direction or guidance present:

Examples illustrated in the experimental section or written description offer no guidance or teachings as to how perform the process of making when said reactive T-Z substituents or those with chemically incompatible substituents are present in the starting material.

5. The presence or absence of working examples:

Although examples 1-10 show the process of making trisubstituted triazines, they are limited to those triazines with no reactive functionality. There are no representative examples showing the viability of the process for plurality of reactive substituents embraced in the instant claims.

6. The breadth of the claims:

Specification has no support, as noted above, for all compounds generically embraced in the claim language would lead to desired compound of formula I, III, IV, V and VI with said reactive groups and there is also no valid chemical reasoning for one trained in the art to expect that all these functional groups would be inert during the process of making .

7. The quantity of experimentation needed:

The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired structure, namely compound of formula I, III, IV, V and VI embraced in the instant claims in view of the prior art teachings of reactivity of these T-Z groups.

Thus, factors such as "sufficient working examples", the "level of skill in the art and predictability, etc. have been demonstrated to be sufficiently lacking in the case for the instant claims.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1,107,143.

GB 1,107,143 discloses several trisubstituted triazines with at least one  $\beta$ -naphthol group as claimed in the instant claims for use as dyes for dyeing variety of materials. See formula shown on page 1 and note the definition of various R and X groups. See page 2-6 for various compounds made which include those claimed in the instant claims. See examples 2-9.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huber et al. US 5,874,576.

Huber et al. teaches several 2-substituted amino-4,6-diaryl-triazines, which include compounds, claimed in the instant invention for the use as light screening agents. See formula I on col. 1 and note the definition of R, R' and Ar groups. Note these definitions include compounds of the instant claims. Note various choices of Ar groups on col. 2 and especially on col. 3. See examples 1-11 on col. 6 through 8.

Instant claims differ from the reference in requiring one  $\beta$ -naphthol group attached to the triazine through  $\alpha$ -carbon of the naphthyl group.

However, Huber et al. teaches the equivalency therein exemplified substituents in examples 1-11 with that claimed in the definition of Ar, R and R'. See cols. 2 and 3. Thus it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compounds variously substituted in triazine ring and the aryl ring as permitted by the reference and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on weekdays from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Venkataraman Balasubramanian

4/4/2002